

REMARKS

Claims 8-12, 22-25, 27-31 and 45-55 were pending in the application at the time the present Office Action was mailed. No claims have been cancelled, added, or amended by the present response. Accordingly, claims 8-12, 22-25, 27-31 and 45-55 remain pending in the present application.

All of the pending claims were rejected in the present Office Action. More specifically, the status of the claims in view of the present Office Action is as follows:

(A) Claims 8-12, 25, 27-31, 45-47 and 50-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,116,402 to Beach et al. ("Beach") in view of U.S. Patent No. 5,282,651 to Alonso ("Alonso"); and

(B) Claims 22-24 and 48-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beach as modified by Alonso, and further in view of U.S. Patent No. 5,137,304 to Silvershotz et al. ("Silvershotz").

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's disclosure. (MPEP 706.02(j); emphasis added.)

In the present case, the Examiner has not met the burden of establishing a *prima facie* case of obviousness because the Examiner has failed to identify any teaching or suggestion in the prior art to make the proposed combination of Beach and Alonso. Instead, the applicant's own disclosure has been used as a blueprint to reconstruct the claimed invention out of isolated and disparate teachings in the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ 2d 1788, 1792

(Fed. Cir. 1988). As explained in greater detail below, the Beach reference is directed to redeemable coin discriminator vouchers, while Alonso is specifically directed to novelty trading cards. Absent impermissible hindsight of the applicant's disclosure, there would be no motivation for one of ordinary skill in the art to combine these disparate and isolated references to produce the claimed invention. For at least this reason, the Examiner has failed to establish a *prima facie* case of obviousness, and the rejections of the pending claims should be withdrawn.

A. Response the Section 103 Rejection of Claims 8-12, 25, 27-31, 45-47 and 50-55

Claims 8-12, 25, 27-31, 45-47 and 50-55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beach in view of Alonso.

1. Independent Claim 8 is Directed to a Voucher that Includes, *Inter Alia*, a Thermally Responsive Indicia Configured to Become Substantially Non-Visible in Response to a Change in Ambient Temperature

Independent claim 8 is directed to a voucher configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers. The voucher includes, *inter alia*, a substrate configured to be dispensed from a coin-counting machine. The substrate includes first indicia and second indicia. The second indicia is configured to become substantially non-visible in response to a change in ambient temperature. At least one of the first and second indicia indicates a value of the voucher.

Independent claims 25 and 29 are also directed to vouchers configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers. Both of these claims include thermally responsive features that are at least generally similar to the thermally responsive second indicia of independent claim 8.

Independent claim 30 is directed to an article of manufacture configured to assist in distinguishing unauthorized duplicate or counterfeit articles. The article of manufacture

includes thermally responsive indicia that is at least generally similar to the thermally responsive second indicia of independent claim 8.

2. Alonso Teaches Interactive Trading Cards

The Alonso reference teaches a trading card in which the image can be varied by interaction with the user. As Alonso states:

"There exists a need for trading cards which are interactive with the user, which reveal other and different information responsive to actions taken by the user. . . . The formally known static trading card thus becomes a game and more than mere collected information."

(Alonso at column 1, lines 30-39). As shown in Figure 1 of Alonso, a trading card 10 depicts a saluting soldier 12. Printed text in an area 16 is not visible by virtue of a coating 18 which blocks viewing of the text unless the coating 18 goes to a transparent or translucent condition when heated above ambient. (See Figures 1-3 of Alonso, and columns 3 and 4, lines 67-59).

3. Alonso and Beach Cannot Support a Section 103 Rejection of Independent Claims 8, 25, 29 and 30 for at Least the Reason That There is no Teaching, Suggestion, or Motivation in the Prior Art to Combine These Isolated References

Obviousness can only be established by combining the teachings of the prior art when there is some teaching, suggestion, or motivation to do so found in the prior art, and not in applicant's disclosure. (MPEP § 2143). In the present case, the prior art lacks any suggestion of the claimed combination. The Beach reference, for example, is directed to vouchers for use with coin discriminators. Alonso, on the other hand, is directed to interactive trading cards. Nowhere does the Alonso reference teach or suggest that the coating 18 can be used as a security feature, much less a security feature for use with a coin discriminator. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01; *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990). Accordingly, if the Examiner persists in the present rejection, the applicant

respectfully requests that the Examiner identify where the prior art suggests combining Alonso with Beach to provide the vouchers of the present claims.

Furthermore, the MPEP explicitly states that "The Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (MPEP § 2142; emphasis added). In the present case, the Examiner has failed to provide *any* reasoning, convincing or otherwise, that relies on "the teachings of the references." The only reasoning the Examiner provides in the Office Action is the motivation taught by the applicant's disclosure, which violates the principle that the Examiner should not "fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." *In re Kotzab*, 217 F.3d 1365, 55 USPQ 2d 1313 (Fed. Cir. 2000).

Not only is there no suggestion or motivation in the prior art to combine Alonso with Beach, but these two references are also non-analogous art, and as the MPEP specifies, non-analogous art cannot be used to establish obviousness. (MPEP § 2141.01). "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be (1) in the field of applicant's endeavor or, if not, then be (2) reasonably pertinent to the particular problem with which the inventor was concerned." (MPEP § 2141.01(a); emphasis added). In the present case, it can hardly be suggested that the trading cards of Alonso are in the field of applicant's endeavor. Indeed, even the PTO has classified these two references in different search classes. Specifically, Beach is classified in search class 194/216 (Check-Actuated Control Mechanisms/Having Solid State Circuitry), and Alonso is classified in search class 283/117 (Printed Matter/Miscellaneous).

The next question is whether the field of trading cards would be "reasonably pertinent" to the particular problem of avoiding counterfeit vouchers. In this regard, the CCPA has stated "For the teaching of a reference to be prior art under Section 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the pertinent problem to which the invention

pertains." *In re Horn*, 203 USPQ 969 (CCPA 1979). In the present case, there is no basis for concluding that one skilled in the particular art of coin discriminator vouchers would have considered the trading card reference of Alonso when trying to overcome the problem of counterfeit vouchers. Perhaps more to the point, nowhere has the Examiner provided any basis for concluding that one of ordinary skill in the art in the voucher field would have performed a search of trading card patents.

Manufacturing trading cards and operating self-service coin discriminators are, most assuredly, different "fields of endeavor" and different "purposes," which defeat the possibility of dealing with or solving a common problem. (*In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992). Accordingly, the combination of Alonso and Beach cannot support a proper Section 103 rejection of independent claims 8, 25, 29 and 30 for at least the reason that there is no motivation or teaching in the prior art to combine these non-analogous references. Therefore, the rejection of these independent claims should be withdrawn.

Claims 9-12 and 45-47 depend from base claim 8, claims 27, 28, 50 and 51 depend from base claim 25, claims 52 and 53 depend from base claim 29, and claim 31 depends from base claim 30. Accordingly, the combination of Alonso and Beach cannot support a Section 103 rejection of dependent claims 9-12, 27, 28, 31, 45-47 and 50-55 for at least the reason that these references cannot support a Section 103 rejection of corresponding base claims 8, 25, 29 and 30. Therefore, the rejection of these dependent claims should also be withdrawn.

B. Response to the Section 103 Rejection of Claims 22-24 and 48-49

Claims 22-24 and 48-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Beach as modified by Alonso, and further in view of Silvershotz.

1. Independent Claim 22 is Directed to a Voucher That Includes, *Inter Alia*, a Thermally Responsive Indicia and a Plurality of Perforations Defining a Pattern

Independent claim 22 is directed to a voucher configured to assist in distinguishing unauthorized duplicate or counterfeit vouchers. The voucher includes, *inter alia*, a substrate having first, second, and third indicia. The first indicia indicates a value of the voucher. The second indicia is configured to change appearance in response to a change in ambient temperature between 75 and 98 degrees Fahrenheit. The third indicia is substantially non-visible, however, rubbing adjacent to the third indicia with an object will render the third indicia visible. In addition to the foregoing features, the voucher of independent claim 22 further includes a plurality of perforations that define a pattern in the substrate.

Independent claim 22 includes a thermally responsive indicia that is at least generally similar to the thermally responsive indicia of independent claim 8 described above. Accordingly, for the reasons set forth above in regard to independent claim 8, the combination of Beach and Alonso cannot support a Section 103 rejection of independent claim 22. Furthermore, Silvershotz fails to cure the deficiencies of Beach and Alonso. Therefore, the combination of Beach, Alonso and Silvershotz cannot support a Section 103 rejection of independent claim 22, and the rejection should be withdrawn.

Claims 23, 24, 48 and 49 depend from base claim 22. Accordingly, the combination of Beach, Alonso and Silvershotz cannot support a Section 103 rejection of these dependent claims for at least the reason that these references cannot support a Section 103 rejection of corresponding base claim 22, and for the additional features of these dependent claims. Therefore, the rejection of dependent claims 23, 24, 48 and 49 should be withdrawn.

In view of the above amendment, applicants believe the pending application is in condition for allowance.

Please charge any deficiency in fees or credit any overpayment to our Deposit Account No. 50-0665, under Order No. 213828013US4 from which the undersigned is authorized to draw.

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Respectfully submitted,

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